

**REMARKS**

**I. Status of the Claims**

Claims 80, 82, 86-93, 97-100, 104-149, and 167-186 stand rejected. By this Amendment, claims 81, 126-133, and 136-138 are canceled without prejudice or disclaimer. Claims 1-79, 84, 85, 94-96, and 101-103 were previously canceled. Claims 81, 83 and 150-166 are withdrawn from consideration. Claims 80, 82, 83, 99, 134, 135, 139, and 185 are amended. By this Amendment, claims 80, 82, 83, 86-93, 97-100, 104-125, 134, 135, and 139-186 are pending.

Independent claim 80 was amended to incorporate elements of claims 131-133, 137, and 139. Independent claim 185 was amended in a manner consistent with independent claim 80. Claims 82, 83, 134, 135, and 139 were amended to be dependent on claim 80. Claims 83 and 135 were amended to further improve clarity. Support for these amendments may be found in the specification and original claims as filed. Accordingly, there is no issue of new matter.

Applicants respectfully thank the Examiner for withdrawing the rejection under 35 U.S.C. § 103(a) over U.S. Patent No. 5,843,417 ("Hanna") in view of U.S. Patent No. 5,196,187 ("Nicoll"). Applicants submit that all of the pending claims are allowable for at least the reasons of record, which are specifically incorporated herein by reference, as well as the following additional reasons.

**II. Rejections under 35 U.S.C. § 103(a)**

Claims 80, 82, 86-93, 97-100, 104-149, and 167-186 are rejected under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 5,843,417 to Hanna et al. ("Hanna") in view of U.S. Patent No. 5,902,592 to Bara et al. ("Bara"). *Office Action at*

pp. 4-6. The Examiner states that Hanna discloses a water-in-oil emulsion comprising iron oxide particles, titanium oxide particles, isododecane, propylene glycol, water, and further comprises moisturizers, polymers, and other ingredients in order to achieve a desired feel and behavior of the composition. *Id.* at p. 5. However, the Examiner states that “Hanna et al. do not teach the specific volatile silicone oils as claimed by applicant.” *Id.* Furthermore, in the Office Action dated August 22, 2008, the Examiner states that “Hanna et al. do not teach the claimed concentration of the ingredients” or “the viscosity of the composition.” In view of these deficiencies, the Examiner relies upon the teachings of Bara for its disclosure of “a composition comprising 2-18% cyclopentadimethylsiloxane and 2-18% cyclohexadimethylsiloxane” to provide “the cosmetic with the ability to be more easily applied to the skin ... and to “further prevent[] the skin tightness and dry feeling.” *Id.* at 5-6.

The Examiner contends that “[i]t would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Hanna et al. with Bara et al” and “[o]ne would have expected success since Hanna et al. and Bara et al. teach oil-in-water cosmetic compositions for topical application.” *Id.* at p. 6.

Applicants respectfully disagree.

Applicants submit that the Examiner has not established a prima facie case of obviousness. In order to meet the initial burden of establishing a prima facie case of obviousness, the Examiner must first show that the prior art references, alone or in combination, teach or suggest all the claimed limitations. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Here, the Examiner fails to meet this burden

because the combination of Hana and Bara do not teach or suggest all of the present claim limitations.

Independent claims 80 and 185 recite, in relevant part, “an aqueous phase comprising: water; a first water miscible polyol comprising 3 carbon atoms and being present in an amount ranging from 5% to 8% by weight, relative to the total weight of the composition; and a second water miscible polyol comprising 4 to 6 carbon atoms and being present in an amount ranging from 1% to 7% by weight, relative to the total weight of the composition, wherein the water, the polyol, and the oil are present in an amount such that the weight ratio of (water + polyol) to oil is greater than or equal to 0.8.” See, e.g., amended claim 1.

As recited in the independent claims, the first water miscible polyol is present in an amount ranging from 5% to 8%, and the second water miscible polyol is present in an amount ranging from 1% to 7%. That is, these amounts refer to the claimed polyols independently, and not the total amount of both combined. In contrast, Hanna merely discloses that the **total amount** of **all** oil surfactant(s) in a W/O emulsion be in the range of 5% to 15%. *Hanna* at col. 5, lines 29-31. Hanna exemplifies the oil surfactants dimethicone copolyol, laurymethicone copolyol, glyceryl stearate, beeswax, cetyl dimethicone copolyol, polyglyceryl-4-isostearate, and hexyl laurate, neither of which fall within the carbon atom ranges claimed for the first and second water miscible polyol. *Id.* at col. 5, lines 3-6. In the sole working example, Hanna lists a single number of 9% for **all** oil surfactants (polyglyceryl-4-isostearate/cetyl dimethicone copolyol/hexyl laurate) used, without specifying the amount of any individual surfactant. *Id.* at col. 7, lines 47-48. Thus, nothing in Hanna would suggest the amount of first and second

water miscible polyol recited in the independent claims; the general disclosure in Hanno lacks the specificity to suggest these claimed amounts.

Moreover, none of the surfactants listed in Hanna (set forth above) fall within the scope of the first and second water miscible polyol carbon atom ranges as recited in claims 80 and 185. Therefore, the general teachings of Hanna are not sufficient to render the present claims obvious. Bara fails to cure these deficiencies.

The Examiner relies on Bara for its specific teaching of the volatile silicone oils cyclopentadimethylsiloxane and cyclohexadimethylsiloxane to cure the deficiency that Hanna fails to teach or suggest combining at least one volatile hydrocarbon-based oil with at least two different volatile silicone oils having distinct flash points. Bara teaches the combination of cyclopentadimethylsiloxane and cyclohexadimethylsiloxane in a composition, but in no way provides any motivation to combine other elements to arrive at the present claims. For example, Bara only exemplifies non-silicone oils in the form of fatty substances, which can be esters of lanolic acid, oleic acid, lauric acid, stearic acid, or myristic acid. *Bara* at col. 3, lines 50-53. And Applicants further direct the Examiner to the even broader teaching of "oily materials." *Id.* at col. 4, lines 64-65. There is nothing in Bara that teaches or suggests the polyols recited in claims 80 and 185, nor is there anything that would indicate to one of ordinary skill in the art that incorporation of polyols, much less those recited in the independent claims, would produce a successful result.

Applicants respectfully submit that there is no reason or evidence provided by Hanna and Bara, alone or in combination, for the skilled artisan to go beyond what is disclosed in these documents in an attempt to arrive at the present claims. For at least

the aforementioned reasons, there is no disclosure that would provide the skilled artisan with any reason to combine and modify the disclosures of Hanna and Bara as suggested by the Examiner. Thus, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness, and request that this rejection be withdrawn.

### **III. Double Patenting Rejection**

Claims 80, 82, 84-149 and 167-186 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 15 and 18-99 of copending U.S. Application No. 10/603,698 ("the '698 application") for the reasons set forth at pages 3-4 of the Office Action. Since the '698 application was filed prior to the present application, Applicants respectfully request that the Examiner hold this rejection in abeyance until there is an indication of allowable subject matter in either this application or the '698 application. At that time, it would be possible to determine in which of these two applications, if any, a Terminal Disclaimer would need to be filed. See M.P.E.P. § 804 (I)(B)(1).

### **IV. Conclusion**

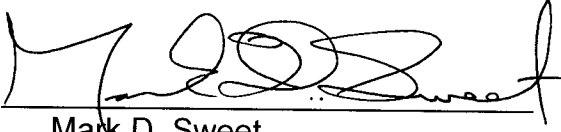
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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